

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Nizar Youssef Mehio

Serial Number: 10/751,119

Filed: Jan. 05, 2004

Title: MODULAR SMOKING
APPARATUS

Examiner: Nguyen, Phu.

Group Art Unit: 1731

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

This brief is submitted in reply to the Examiner's Response filed on November 15, 2007 and contains these items under the following headings and in the order set forth below:

- I. STATUS OF CLAIMS
- II. ISSUES
- III. ARGUMENT - REJECTIONS UNDER 35 U.S.C. §§ 102, 103, and 112.

The final page of this brief bears the practitioner's signature.

I. STATUS OF THE CLAIMS

The status of the claims in this application is as follows:

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims 24, 25, 27-40, and 43-45 are in the application.

B. STATUS OF ALL THE CLAIMS

1. Claims canceled: 1-23, 26, 41, 42, and 46.
2. Claims withdrawn from consideration but not cancelled: None
3. Claims pending: 24, 25, 27, 28-40, and 43-45.
4. Claims allowed: None
5. Claims rejected: 24, 25, 27, 28-40, and 43-45.

C. CLAIMS ON APPEAL

The claims on appeal are claims: 27, 28-40, and 43-45.

II. ISSUES

1. Whether claim 27 is obvious over Zahariadis' U.S. Patent No. 1,513,147 in view of the knowledge of one of ordinary skill in the art.
2. Whether claim 36 is obvious in light of the Ganim's U.S. Patent No. 722,405 in view of Kahler's U.S. Patent No. 3,872,872.
3. Whether claim 40 is anticipated by the Zahariadis' U.S. Patent No. 1,513,147 and obvious.
4. Whether the discussion of claim 24 of the August 15, 2007 amendment is moot.

III. ARGUMENTS

A. REJECTION OF CLAIM 27 UNDER 35 U.S.C. 103

To Err in Equating Air to a Plenum

The Examiner clings to the rationale that the plenum, which Applicant clearly indicates is a physical component by his claim language and by reference to the specification, equals space within the upper portion of the base of the Zahariadis reference. This space encompassed by Zahariadis' element 5 neither defines neither a wet smoke aperture nor a dry smoke aperture. It is clearly stated that Zahariadis' wet smoke aperture 17 is defined entirely within Zahariadis' element 3. Zahariadis, page 1, lines 71-75; and FIGS. 1 & 4. Zahariadis' dry smoke aperture is formed almost entirely within his element 16. *Id.*, page 1, lines 65-70; and FIGS. 1 & 4. In fact, dry smoke can never contact the space created by Zahariadis' element 5 because the smoke has necessarily been submerged within the fluid 2 prior to reaching that space.

Furthermore, to accept the rationale that the space within Zahariadis' element 5 is a plenum would ignore the limitation in Applicant's claim 27 that the down tube fastens to the plenum. The Examiner in his Answer attempts to find a down tube that attaches to Zahariadis' packing material by generally citing FIG. 1. It is unclear exactly where Zahariadis' element 16 connects to his element 5.

In addition to the five differences between Applicant's plenum and Zahariadis' base-circumscribing packing material listed in Applicant's initial brief, Applicant would like to further submit the above differences.

B. REJECTION OF CLAIM 36 UNDER 35 U.S.C. 103

The Examiner's Answer continues the reasoning of the Examiner's Actions that attempts to construe the attributes of Applicant's components without reference to Applicant's specification. For example, Examiner on his page 12, maintains that Applicant's burner is properly analogous to Ganim's element P "since it holds and burns tobacco." Upon reading Applicant's brief, and Applicant's specification, e.g. par [0018] and FIGS. 1-4, 8, and 9, it is clear that the burner is not the bowl where tobacco is ignited, but instead the portion of the stem that holds that bowl. An examination of Applicant's FIG. 2 shows that if one attempted to place tobacco into Applicant's burner that it would fall right through the stem and into the base. The identification of the other elements poses similar errors previously mentioned in Applicant's Appeal brief.

In addressing specifically the analogy of Ganim's post D to Applicant's plenum, it should be noted that Applicant's plenum is by limitation capable of both dry smoke transport and wet smoke transport. The Ganim post merely includes wet smoke transport. The Examiner's Answer on page 13 attempts to alter the Examiner's Action of 4/3/2007 (page 5) by stating that the plenum includes Ganim's elements D and H – rather than simply the previously cited D. Even if this new rejection formulation were entertained for the first time on appeal, it is held that minimizing the number of elements to perform a function can be a significant source of non-obviousness. *See, e.g., In re Kotzab*, 217 F.3d 1365 (Fed. Cir. 1999)(Invention that included a single sensor in communication with multiple valves not obvious over multiple sensor communicating with multiple valves.) It is also unlikely that a person of ordinary skill in the art would be motivated to fuse the functionalities of this element D to the element H, considering that

the removability and smoke-bypass aspects of the down tube H are the heart of the Ganim invention. Additionally, Applicant claims that the plenum forms a portion of the dry smoke transport that releases smoke into the down tube. To accept the Examiner's new contention would be to condone the logic that a component releases smoke into itself although that component forms the entirety of the smoke transport.

The Examiner's Answer, on his page 13, further finds element I as capable of transporting wet smoke. Ganim's FIGS. 1 and 4 with reference to his actual wet smoke outlet B⁵ clearly indicate that wet smoke, or any other kind of smoke, never enters space I. The wet smoke outlet is clearly defined, and Ganim relieves any uncertainty: "smoke...is cooled by the water and rises to the outlet-passage B⁵... *Ganim*, lines 63-66. This Ganim hookah that relies on a single dry smoke delivery component ought not be stretched, contorted, and sliced into rendering obvious Applicant's multiple stacked component stem, each subsuming a portion of the dry smoke transport and contributing to the modular, space-saving characteristics of the present invention.

C. REJECTION OF CLAIM 40 UNDER 35 U.S.C. 102

The Examiner's Answer marks the third change in the Examiner's rationale for finding the intermediate tube of Applicant's claim 40 (and claim 42 prior to its incorporation by amendment into claim 40) in cited references. In the first Examiner's Action of 10/10/2006 the Examiner found the Applicant's plenum in Ganim; in the second Examiner's Action of 4/3/2007 the Examiner found the Applicant's intermediate tube in Zahariadis' element 18, and now the Examiner's Answer cites a plenum analog in Zahariadis' element 3.

Applicant wishes to stand on the arguments of its first brief, but urges the Examiner to declare the newest contention “A New Ground of Rejection” in the Examiner’s Response to Reply Brief and reopen prosecution. As M.P.E.P. § 1207.3(III) states, a new ground of rejection occurs when the thrust of rejection occurs such that the Appellant has not been given a fair opportunity to react to the rejection. Here the mistake, irrespective of an inadvertency, has completely altered the framework of the discussion with respect to non-obviousness.

D. MOOTNESS OF PROPOSED CLAIM 24

Examiner neglected to respond to Applicant’s arguments that the proposed amendment of August 15, 2007 citing mootness. A case presents justiciable controversy if there is actual dispute between adverse litigants and substantial likelihood exists that favorable court decision will produce some effect on legal rights of parties. *In re Jones*, 176 B.R. 645 (D.N.H. 1994). An action is moot where a party already has received all of the relief which would result from favorable court ruling. *See, e.g., Wysocki v. Sullivan*, 761 F.Supp. 693 (C.D.Cal.1991).

In the present instance, the unilateral actions of the Examiner have declared an amendment invalid for puzzling reasons. This amendment, if entered, would allow a simplified analysis of the claims at issue.

Furthermore, even if deemed moot by the Board, upon a determination of non-obviousness the Applicant wishes to have the claim amendment of August 15, 2007 entered with a determination that the claim is valid according to 35 U.S.C. § 112. Such a determination would obviate any further proceedings on claim 24.

Respectfully Submitted,



Date: 4/15/08

M. Keith Blankenship, Esq.
Reg. No. 53,997
General Counsel, P.C.
6862 Elm Street
Suite 800
McLean, VA 22101
Phone: 703-556-0411
Fax: 703-556-6540